

REMARKS

The Examiner rejects claims 1-7, 9-17, 22-28, 30-33, 38-47, 52-56, and 59-64. The Examiner objects to claims 8, 18-21, 29, 34-37, 48-51, 57, and 58. Applicants have added no new claims. Claims 1-64 are pending and under consideration.

Claims 1, 25, and 64 have been amended to recite the language "macerating whole tissue, wherein the whole tissue is not blood," and to replace the language "biological sample" with the language "whole tissue." Support for these amendments may be found in the specification, e.g., at paragraph 58 bridging pages 18 and 19; page 21, lines 17-19; and Examples 2, page 38, line 21 to page 39, line 10; and Examples 15 to 22, page 78, line 6 to page 88, line 2. These amendments add no new matter.

Objections to Claims

The Examiner objects to claims 8, 18-21, 29, 34-37, 48-51, 57, and 58 as being dependent upon a rejected base claim. See Office Action, page 4, Item No. 5.

As the Applicants show below, the base claims upon which the objected claims are dependent are in condition for allowance, and the Examiner's objection is moot. Applicants respectfully request reconsideration and withdrawal of the claim objections.

Rejection Under 35 U.S.C. § 102(e)

The Examiner rejects claims 1-7, 9-17, 22-28, 30-33, 38-47, 52-56, and 59-64 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Pat. No. 6,548,256 to Lienau et al., ("Lienau"). Office Action at pages 3 to 4, Item No. 4.

The Examiner states that "Lienau discloses a method and kit for isolating nucleic acids from a nucleic acid containing starting material, where the nucleic acids are released from the starting material and precipitated onto a trapping membrane." Office

Action at page 3, lines 3 to 5. The Examiner states that "[t]he method and kit may be used in the context of isolating genomic DNA from blood and isolating BACs from transformed bacterial cultures. Office Action, page 3, lines 5 to 7. "The method includes mixing the starting material with a lysing and denaturing substance for release of the nucleic acid from the starting material. . . . Typically, the lysing and denaturing substance includes a buffering agent, a salt, . . . a detergent and a protease." Office Action at page 3, lines 7-12. The Examiner states that Example I in Lienau describes a method of treating a blood sample which includes a step in which "alcohol and detergent substance, (70% isopropanol and 30% Tween 20) was added to the supernatant" Office Action at page 3, lines 19-21. The Examiner stated that this step "is viewed to be inclusive of the neutralizing step of the cationic detergent (see definition of the instant specification on page 21, lines 9-12)." Office Action at page 3, lines 19 to page 4, line 1.

Without acquiescing to the Examiner's rejection and solely to expedite prosecution, claims 1, 25, and 64 have been amended to recite the language "macerating whole tissue, wherein the whole tissue is not blood" and to replace the language "biological sample" with the language "whole tissue." Support for these amendments may be found, e.g., in the specification at paragraph 58 bridging pages 18 and 19; page 21, lines 17-19; and Examples 2, page 38, line 21 to page 39, line 10; and Examples 15 to 22, page 78, line 6 to page 88, line 2.

Lienau discusses methods of obtaining nucleic acid from single cells in suspension, but not for "macerating whole tissue, wherein the whole tissue is not blood" as recited in claims 1 and 25. The only starting materials that "have a target nucleic

acid for isolation" listed by Lienau are collections of single cells or cells in a liquid suspension, such as blood or saliva. Such collections of single cells or cells in liquid suspension are not literally encompassed by the language "macerating whole tissue" in claims 1 and 25.

Nowhere does Lienau teach a method of "macerating" whole tissue, according to claims 1 and 25. Thus, Lienau does not anticipate claims 1 and 25. Claims 2-7, 9-17, 22-24, 26-28, 30-33, and 38-40 ultimately depend from one of claims 1 and 25. Thus, Lienau does not anticipate claims 2-7, 9-17, 22-24, 26-28, 30-33, and 38-40.

Claims 41 is drawn to a kit comprising a protease, a cationic surfactant, and a "second surfactant, wherein the second surfactant substantially neutralizes the cationic surfactant" Claims 64 is drawn to a kit comprising a protease, a cationic surfactant, and a "non-ionic surfactant, wherein the non-ionic surfactant permits the binding of nucleic acid to a solid phase in the presence of the protease and cationic surfactant"

In the rejection, the Examiner did not explain how Lienau could anticipate claims 41 or 64. Nowhere does Lienau discuss a kit comprising a all of the elements of claim 41 or a kit describing all of the elements of claim 64.

The Examiner asserts that the "added functions which the prior art has not analyzed" in claims 44-47 are "inherent in the prior art composition" because the Examiner believes the "rejection analysis substantiat[es] the basic characterization of the composition of the invention being the same as the reference." Office Action, page 4, lines 7-10. Contrary to the Examiner's assertion, that analysis does not show a kit according to either claim 41 or claim 64. The Examiner has not shown or even

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

suggested how Lienau could anticipate claims 41 and 64. Office Action, page 4, lines 7-10. Thus, the Examiner has failed to establish that Lienau anticipates claims 41 and 64.

Claims 42-47, 52-56, and 59-63 ultimately depend from claim 41. Thus, Lienau does not anticipate claims 42-47, 52-56, and 59-63.

Applicants respectfully request reconsideration and withdrawal of the §102 rejection.

Conclusion

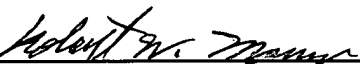
Applicants respectfully assert that the application is in condition for allowance. If the Examiner does not consider the application to be in condition for allowance, Applicants request that the Examiner call the undersigned at (650) 849-6676 to arrange an interview prior to taking action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Robert W. Mann
Reg. No. 48,555

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER ^{LLP}

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com